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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,845	11/21/2001	James E. Lerch JR.	011215	1251

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EXAMINER	
GARCIA, ERNESTO	

ART UNIT	PAPER NUMBER
3679	

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/989,845	LERCH, JAMES E.	
	Examiner	Art Unit	
	Ernesto Garcia	3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 August 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,7-12,14-16,18-22 and 24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,7-12,14-16,18-22 and 24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 8-10 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Case, 3,388,892 (see marked-up attachment provided in last office action).

Regarding claim 1, Case discloses an improvement comprising at least one longitudinally extending railing **82**, vertically extending posts **56**, and fastening means **42c**.

The railing **82** has at least one generally T-shaped channel **86**. The channel **86** extends in a longitudinal direction **A3** of the railing **82** and at least one leg **A12** of the channel **86** extends inwardly within the channel **86**.

The posts **56** each have an elongated body **A5** and at least two flange segments **58**. The flange segments **58** extend outwardly in opposite directions **A7** and have at least one perforation **71** in each of the flange segments **58**.

The fastening means **42c** are slidably embraced within the channel **86** and the fastening means **42c** extend through the perforation **71** in the flange segments **58** and fastened to the posts **56**.

Regarding claim 8, given the improvement as recited in claim 1 above or the apparatus as recited in claim 18 below, the method is inherently performed when the improvement or the apparatus is assembled.

Regarding claims 2, 9 and 19, the T-shaped channel **86** has an inwardly extending tab **A12** at an end of a leg **A13** of the channel **86**.

Regarding claim 18, Case discloses in Figures 1-3 an apparatus comprising a barrier **32**. The barrier **32** has at least one longitudinally extending railing **82**, vertically extending posts **56**, and fastening means **42c**.

The railing **82** has at least one generally T-shaped channel **86**. The channel **86** extends in a longitudinal direction **A3** of the railing **82** and at least one leg **A12** of the channel **86** extends inwardly within the channel **86**.

The posts **56** each have an elongated body **A5** and at least two flange segments **58**. The flange segments **58** extend outwardly in opposite directions **A7** and have at least one perforation **71** in each of the flange segments **58**.

The fastening means **42c** are slidably embraced within the channel **86** and the fastening means **42c** extend through the perforation **71** in the flange segments **58** and fastened to the posts **56**.

Regarding claims 3, 10 and 20, the railing **82** has another T-shaped channel **90** thereby the railing **82** has at least two T-shaped channels **86,90**.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-2, 4, 5, 7-9, 11, 12, 14-18, 19, 21, 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over McMullin, 3,258,250 (see marked-up attachments provided on last office action), in view of Case, 3,388,892.

Regarding claim 1, McMullin discloses an improvement comprising at least one longitudinally extending railing **37**, vertically extending posts **11**, and fastening means **34**.

The railing **37** has at least one generally T-shaped channel **A2**. The channel **A2** extends in a longitudinal direction **A3** of the railing **37** and at least one leg **45** of the channel **A2** extends inwardly within the channel **A2**.

The posts **11** each have an elongated body **14** and at least two flange segments **A6**. The flange segments **A6** extend outwardly in opposite directions **A7** and have at least one perforation **32** in at least one of the flange segments **A6** (Fig. 1; attachment).

The fastening means **34** are slidably embraced within the channel **A2** and the fastening means **34** extend through the perforation **32** in the flange segments **A6** and fastened to the posts **11**. However, McMullin does not show another perforation in the other one of the flange segments **A6** thereby making each of the flange segments **A6** having at least one perforation to connect the rail. Case teaches in Figure 7 at least one perforation **71** in each flange segment **58** to connect a rail to a post. Therefore, as taught by Case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include at least one perforation **32** in each of the flange segments **A6** to connect the rail to the posts.

Regarding claims 2, 9 and 19, the T-shaped channel **86** has an inwardly extending tab **45** at an end of a leg **41** of the channel **A2**.

Regarding claims 4, 11 and 21, the railing **37** has a T-shaped slot **A11**.

Regarding claims 5, 12 and 22, the flange segments **A6** extend at 180 degrees angle to each other.

Regarding claim 8, given the improvement as recited in claim 1 above or the apparatus as recited in claim 18 below, the method is inherently performed when the improvement or the apparatus is assembled.

Regarding claim 18, McMullin discloses in Figures 1 and 3 an apparatus comprising a barrier **36**. The barrier **36** has at least one longitudinally extending railing **37**, vertically extending posts **11**, and fastening means **34**.

The railing **37** has at least one generally T-shaped channel **A2**. The channel **A2** extends in a longitudinal direction **A3** of the railing **37** and at least one leg **45** of the channel **A2** extends inwardly within the channel **A2**.

The posts **11** each have an elongated body **14** and at least two flange segments **A6**. The flange segments **A6** extend outwardly in opposite directions **A7** and have at least one perforation **32** in each of the flange segments **A6**.

The fastening means **34** are slidably embraced within the channel **A2** and the fastening means **34** extend through the perforation **32** in the flange segments **A6** and fastened to the posts **11**.

Regarding claims 7 and 24, McMullin, as discussed above, discloses the railing **37** and the posts **11** are formed from metal (col. 1, lines 11-17). However, McMullin

fails to disclose the metal being aluminum by an extrusion process. Applicant is reminded that, within the general skill of a worker in the art, selecting a known material on the basis of its suitability for the intended use is a matter of obvious design choice. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the railing and the vertical post from aluminum. *In re Leshin*, 125 USPQ 416. Furthermore, applicant is reminded that the method of forming the railing and the posts by an extrusion process is not germane to the issue of patentability of the device itself. Therefore, this limitation has been given limited patentable weight. See MPEP ' 2113.

Regarding claims, 14-17, it is well know in the art to make a railing, posts or both by an extrusion process.

Response to Arguments

Applicant's arguments filed 8/25/03 have been fully considered but they are not persuasive.

Regarding claim 1, applicant has argued that Case, 3,388,892, does not teach a longitudinally extending railing having a T-shaped channel. Applicant is urged to view column 3 in lines 36-38 of Case and specially channel 86 in Figure 4. The channel is T-shaped to allow the head of the screw 42c to be held in place.

Regarding claims 1, 2, 4, 5, 7-9, 11, 12, 14-18, 19, 21, 22 and 24 as anticipated by McMullin, 3,258,250, in view of Case, 3,388,892, the applicant argued that there is no motivation to combine McMullin and Case as McMullin relates to bridge rails, Case relates to wire fabric, and McMullin teaches H-shaped support posts. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Furthermore, applicant has objected to the Examiner for taking judicial notice on making railings or posts by an extrusion process, as the process is well known in the art. Again, the examiner takes this official notice as making posts or rails or both are known in the art of making fences. Applicant even requested for such a reference and a motivation to combine the reference to use wire fabric as taught in Case. To applicant's request, applicant is urged to review the references of record. Bidwell's abstract, 3,822,863, teaches posts made by an extrusion process, and the British patent, GB-2,129,845, teaches the same on column 2, in lines 69-71. Regarding the motivation to combine the reference to use wire fabric as taught by Case, there is no requirement that the reference require to use wire fabric since the rejected claims do no require wire fabric and the rejection is base solely on combinations of references.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure. GB-1,396,301 shows a similar barrier.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H Browne can be reached on 703-308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

Lynne H. Browne
Supervisory Patent Examiner
Technology Center 3600

E.G.
November 7, 2003